

Appl. No. 10/050,520
Amdt. dated Nov. 10, 2004
Reply to Office Action of Oct. 25, 2004

REMARKS/ARGUMENTS

By the above amendment, Applicant has rewritten all claims to define the invention more particularly and distinctly to overcome the technical rejections and define the invention patentably over the prior art.

Rejection on New Issues

The last office action rejecting the proposed amendment on new issues is noted. The applicant is herewith filing a request for continued examination and is here submitting superceding claims defining patentability.

The Rejection Of Claims 59-83 On Annunziata In View Of Hoffman Are Overcome As The Rewritten Claims Recite Novel Physical Features

A prior OA rejected independent claims 59 and 72 and dependent claims 60-71 and 73-83 on Annunziata in view of Hoffman. The claims have been rewritten as independent claims 59, 68 and 72 and dependent claims 60-67, 69-71 and 73-83 to define patentability over these references.

Applicant requests reconsideration of this rejection, as now applicable to claims 59 to 83 for the following reasons:

- (1) With regard to the rewritten independent claims 59 and 72. The applicant claims a deformable support sheet member including an aperture and said support member adapted to engage the loop member (claimed as continuous) in the aperture.
- (2) The deformable support sheet member (the label) in the Annunziata device does not include an aperture, nor is the support member adapted to engage the loop member in any aperture.
- (3) With regard to independent claim 68. The applicant claims a continuous loop member including an aperture and a deformable support sheet member including a tab extension, the tab locatable in the aperture to engage the loop member.

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(4) The loop member in Annunziata does not include an aperture. The deformable support sheet member (the label) in the Annunziata device does not include a tab extension, nor is any tab locatable in the loop aperture to engage the loop member.

(5) There is no suggestion in the Annunziata disclosure that the label should include either an aperture or a tab extension. There is also no suggestion in Annunziata that the continuous loop member should include an aperture. Given the device design and objectives of the invention (Column 1, lines 16-20 & lines 32-37) it is not seen how such elements could be included.

(6) Annunziata describes a flat rotatable paper loop member, a conventional glass bottle container, and a pair of standard pharmacy paper labels. The labels, one of which supports the loop, serve as guide rails for rotation of the loop around the container. A modified arrangement employs a single standard pharmacy paper label, which from the illustration and operating description, also appears to serve as a guide rail and support for the loop. The relative engagement positions of the components are necessary for operation of the device. Operation of both versions is the same, consisting entirely of rotating the loop at the supporting guide rail to make a selection. It is evident from the description and illustrations that container rigidity is material to maintaining the loop on the container and material to correct operation of the device. There is no suggestion that the device could be made to work with a deformable container or that the device could be made to work with a container other than the conventional containers shown. The Hoffman container (the support) too is rigid (and is not a deformable sheet member) and there is no suggestion that the Hoffman loop (expandable, not flat and not continuous) could be made to work with a deformable container. There is also no suggestion in Hoffman that a deformable continuous loop could be made to work in the Hoffman device.

(7) A prior office action states that "... Annunziata does not teach against modifying the time indicator or the container, such as modifying the container and time indicator to include anti-rotation means as disclosed by Hoffman. Figure 6 of the Annunziata reference could easily be modified as such". The Hoffman device requires the molding of a custom tapered flange container. Furthermore employing the Hoffman container would require costly molding for

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every size and container that could be served by the disclosed Annunziata device. Not only would the unit cost of such containers be higher than those taught by Annunziata, the duplication of inventory and storage requirements for pharmacies would present a substantial barrier to adoption.

(8) There is no indication in Annunziata that consideration should be given to otherwise construct the loop member, or any cooperating members. There is strong implication to the contrary. The motivation in Annunziata is to produce a reminder device that lowers cost by utilizing a standard label (Column 1, lines 16-20 & lines 32-37). Taken as a whole, the implicit implication in the disclosure is that the container should also be standard or uncustomized.

(9) The overriding motivation in Annunziata is not merely to construct a reminder device, but to construct one that is lower in cost than existing reminders. Annunziata extols cost savings. Utilizing a standard pharmacy label is presented as meaningful in achieving the goal and a significant advantage is ascribed to the use of a conventional full size pharmacist's label in the device (Column 3, lines 70-75 & Column 4, lines 1-5). Taken as a whole, the strong inherent implication is that standard components should be used to reduce cost. The use of an unconventional container as in Hoffman would invalidate the device rationale put forth by Annunziata and eliminate the cost advantage gained from the use of a standard pharmacy label.

(10) The motivations in the two references are competitive. As the base reference, motivation for the combined reference should weigh in favor of Annunziata. It is also not seen what motivation someone of average skill at the time of the invention would have to combine the references in the manner postulated. Combining the Hoffman container with the continuous loop member of Annunziata brings the same increased container costs and obstacles to acceptance (later described) associated with the Hoffman container without the changeable and reusable advantage (Column 2, line 67 to Column 3, line 8) of the Hoffman split ring. It is not seen what advantage such a device would have over Hoffman alone.

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(11) The prior office action states that modifying Annunziata with the Hoffman container would be easy, "Figure 6 of the Annunziata reference could easily be modified as such.", but offers no motivation for combining the references. Ability to combine is not a *prima facie* case of obviousness. Motivation to combine cannot be predicated on a disregard for the reason for and strong implications of the base device, and certainly cannot be one which renders the base device rationale irrelevant.

(12) Furthermore modifying the container and time indicator according to Hoffman would change the operating principle of the Annunziata device. From one requiring rotation of the continuous loop, with possible benefit of the label guide rail in order to make a selection, to one requiring axial displacement of the loop against variable resistance while rotating the loop without benefit of the guide rail. The changed operation also demands a greater degree of skill and dexterity on the part of the user. There is no indication in Annunziata that changing selections should require more than rotation of the loop. There is also no indication in Annunziata or Hoffman that a continuous loop member should be otherwise engaged with a deformable support member or otherwise engaged with a container than that disclosed in Annunziata. The postulated combination eliminates any mechanical contribution made by the deformable label and in effect produces the Hoffman device with a continuous loop in place of the split ring spring. It is also not seen how the flat paper continuous loop taught by Annunziata could be made to expand and contract like the flanged split ring spring of Hoffman for correct axial displacement in the combined device. It is not reasonable to suggest that someone of average skill in the art would modify two components in Annunziata, if they could modify one comparable component in Hoffman to arrive at the postulated condition. Modification of the Annunziata container according to Hoffman is not reasonable.

(13) Even if the glass or other rigid container and the loop in Annunziata could be altered according to Hoffman, the device would still not meet the applicant's claims, as the applicant claims a deformable support sheet member structurally modified from that of Annunziata.

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(14) Altering the standard pharmacy label (a deformable sheet member) would be precluded according to the teaching of Annunziata. Annunziata teaches against modifying the label (Column 3, lines 70-75 & Column 4, lines 1-5). Additionally, the prior office action admits that "Annunziata only at best prevents modifying the label . .". A combined device would therefore have to include the unmodified Annunziata label. The unmodified label of Annunziata cannot meet the applicant's claim.

(15) The applicant therefore submits that the Annunziata device does not include the continuous loop member or deformable support sheet member of the applicant's claims and that the reference lacks any suggestion that they be modified in a manner to meet the claims. The applicant also submits that there is no suggestion in Hoffman that Annunziata be modified in a manner to meet the claims. The applicant further submits that there is no prior art other than the applicant's which suggests that Annunziata be modified in a manner to meet the claims.

(16) With regard to the rewritten dependent claims 60-67, 69-71 and 73-83. The rewritten dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them patentable over this reference.

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**The Novel Physical Features Of The Amended Claims Produce
New And Unexpected Results And Hence Are Unobvious
And Patentable Over These References Under § 103.**

Also applicant submits that the novel physical features of the amended claims are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Annunziata in view of Hoffman. These new and unexpected results are a simpler, and lower cost device than the combined references, and greater likelihood of adoption.

A prior office action indicates that the Annunziata container could be modified according to Hoffman. The applicant's support member obviates the need for a custom container (required in Hoffman). Use of such a container would necessitate costly production of a range of sizes of bottles, vials and jars duplicating capacities of current standard containers. Not only would the unit cost of such containers be higher than present to users, the duplication of inventory and storage requirements would present a substantial obstacle to adoption.

A still further advantage of applicant's device is that single-step automated application of both the loop and support is possible by adaptation of label application technology in widespread use today. That task is much more difficult, if at all possible, for the combined reference.

Inadvertent displacement of the loop indicator in Annunziata would render the device unsuitable for important use, particularly for pharmaceuticals. The applicant's design makes a selection more secure. The high cost of a custom container and associated additional costs in Hoffman present tremendous obstacles to acceptance. The applicant's device may be employed with standard containers in use today. The applicant's device is vastly superior to that of Annunziata, to that of Hoffman, and to that of the postulated combined reference.

Conclusion

For all of the above reasons, applicant submits that the claims are now in proper form, and that the claims all define patentability over the prior art. Therefore the applicant submits that this application is now in condition for allowance, which action is respectfully solicited.

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Conditional Request For Constructive Assistance

Applicant has amended the claims of this application so that they are proper and define novel structure which is also unobvious. If, for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. § 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very respectfully,

Harry Giewercer



Applicant Pro Se

29 Hyde Park Drive
Richmond Hill, Ontario Canada L4B 1V2
Tel. (905) 881-1603; Fax. (905) 889-0854

CERTIFICATE OF FACSIMILE TRANSMISSION

I certify that on the date below I will fax this communication, and attachments if any, to Technology Center 2800 of the Patent and Trademark Office at the following central number (703) 872-9306.

Date: Nov. 12, 04. No. of pages: 15

Inventor's Signature: H. Giewercer